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REMARKS

Applicants appreciate the detailed examination evidenced by the Official Action mailed on March 11, 2004, (hereinafter the "Official Action"). Applicants also appreciate the indication that Claims 6, 14, 20, 26, 27, and 35, include patentable subject matter and would be allowable if rewritten in independent form. In response, Applicants have rewritten these claims as suggested by the Examiner, thereby placing these claims in condition for allowance which is respectfully requested.

However, Applicants respectfully traverse the rejection of the remaining claims as Raith does not disclose or suggest all the recitations of the claims as required under Section 103. As described below in further detail, as understood by Applicants, Raith does not disclose or suggest, at least, performing an operation that is "mutually exclusive of camping on the TDMA digital control channel" or "storing the TDMA control channel information" and "using the stored TDMA digital control channel information to acquire service for the wireless terminal." *See Independent Claims 1, 11, 21, and 30.* Applicants respectfully request reconsideration of the pending claims and allowance thereof in due course for at least the reasons discussed herein below in greater detail.

Independent Claims 1, 11, 21 and 30 are Patentable Over Raith

Claims 1-5, 9-13, 15-19, 21-25, 28-29 and 31-35 stand rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,768,267 to Raith et al. (hereinafter "Raith"). *Official Action, page 2.* Applicants respectfully traverse the rejection of the independent claims as Raith does not disclose or suggest all of the recitations of the claim as required under Section 103.

As understood by Applicants, Raith discusses a communication system wherein mobile terminals begin operating in the communication system by acquiring a digital control channel. Once the digital control channel of Raith is acquired, the mobile is assigned a packet data channel that is associated with the digital control channel. In other words, as understood by Applicants, when the mobile terminal of Raith is powered on, the mobile terminal detects the digital control channel and is directed to a beacon packet data channel that is associated with the control channel first acquired by the mobile terminal. Once the

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mobile terminal in Raith receives the beacon packet data channel, the mobile terminal may be further assigned to yet another packet data channel that is associated with the beacon packet data channel. *See Column 12, line 41-Column 14, line 16 of Raith.* However, Raith does not disclose or suggest any operations which are mutually exclusive of one another. For example, as understood by Applicants, the mobile terminal in Raith appears to operate on a digital control channel and a packet data channel simultaneously so that the system can send commands to the mobile over the digital control channel as well as sending/receiving data to/from the mobile over the packet data channel. Accordingly, as understood by Applicants, **Raith discusses performing operations simultaneously, not mutually exclusively.**

Furthermore, as understood by Applicants, Raith does not disclose or suggest storing TDMA digital control channel information and using the stored digital control channel information to acquire service (to enable the wireless terminal to restore camping on the digital control channel). In sharp contrast to Raith, in some embodiments according to the invention, as discussed, for example, in the reference to Figure 6 of the Application, before performing a first operation, such as scanning or camping, the wireless terminal receives a request to perform a second operation that is mutually exclusive of the first operation (which can be, for example, performing voice-activated dialing or playing a media object). The wireless terminal performs one of the operations and then the other. For example, in some embodiments according to the invention, the mobile terminal may suspend camping and play a media object (such as an MPEG object) whereupon after playing the media object, the wireless terminal returns to the control channel on which the mobile is previously camped prior to receiving the request to play the media object. *See Application, page 15, line 20 - page 16, line 12.* Accordingly, Raith does not disclose or suggest at least these recitations of the independent claims.

The Official Action also does not set-out clear and particular evidence of a suggestion or motivation to modify Raith as required under Section 103. In particular, Applicants respectfully submit that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. The prior art reference (or references when combined) must teach or suggest *all* the claim limitations. There must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and there must be a reasonable expectation of success of the combination. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found *in the prior art*, not in applicant's disclosure. See MPEP § 2143. As affirmed by the Court of Appeals for the Federal Circuit, to support combining references in a § 103 rejection, evidence of a suggestion, teaching, or motivation to combine must be *clear and particular*, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

As discussed above, several of the recitations of the claims are not disclosed by Raith. The Official Action states that "it would have been obvious for one of ordinary skill in the art at the time of the invention that the mobile stores the neighbor lists or PDCH assignment in order for the invention to work." *Official Action, page 3*. Respectfully, this motivation relied on by the Official Action, is not the type of clear and particular evidence required of a rejection under Section 103. The Official Action appears to be relying on the allegation that Raith discusses storing neighbor lists or packet data channel assignment. Even if this were considered true, storing this type of information does not appear relevant to the actions of storing a control channel upon receiving a request for a mutually exclusive operation and then using the stored control channel information to re-acquire service for the mobile as recited in the independent claims.

Furthermore, the motivation offered by the Official Action also appears to rely on hindsight in reasoning that "the mobile stores the neighbor lists . . . in order for the invention to work." (emphasis added). In other words, it appears that the motivation relied on by the Official Action is being provided by looking to the invention for a road map as to how to modify Raith, which is improper hindsight. In view of the above, there is no clear and particular evidence of a suggestion or motivation Raith as required under Section 103 present by the Official Action.

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Accordingly, independent Claims 1, 11, 21, and 30 are patentable over Raith for at least the reasons discussed above. Furthermore, the remaining dependent claims are patentable at least per the patentability of the independent claims from which they depend.

CONCLUSION

Applicants have shown herein that Raith does not disclose or suggest the recitations of the pending claims. Accordingly, Applicants respectfully request the withdrawal of all rejections and the allowance of all claims in due course. If any informal matters arise, the Examiner is encouraged to contact the undersigned by telephone at 919-854-1400 for expeditious handling.

Respectfully submitted,


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Robert N. Crouse

Date of Signature: June 14, 2004